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| KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005 | | | SMITH, JAMES G | |
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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 06012004

Application Number: 10/034,119
Filing Date: January 03, 2002
Appellant(s): LLOYD, CARTER F.

Laleh Jalali
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08 April 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 49-49 and 60 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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| | | |
|-----------|-------|---------|
| 4,669,341 | Small | 6-1987 |
| 5,964,130 | Wang | 10-1999 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 49-55 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Verna.

Small shows the claimed invention except for the use of jaws that have surfaces that will allow for an evenly distributed force along a width thereof when in use, e.g. a substantially flat surface. Verna suggests that a pulling type of pliers tool can have such jaws that will apply an even force along the width of the jaws. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Small by using a jaw surface that will allow for the even application of force along the width of the jaw surface because Verna suggests the use of such a jaw construction when in used on substantially flat surfaces.

Claims 56-60 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Verna as applied to claims 49-55 above, and further in view of Wang(130).

Small, as modified by Verna, shows the claimed invention except for the use of a "flat" surface that will apply a force to a shingle and the use of a pivotally attached jaw plate. Wang(130) suggests that a pliers type of tool can have a flat surface (312) on a pivotally attached jaw (31). It would therefore be obvious to one skilled in the art at the time the invention was made to modify Small by using a completely flat

gripping surface and at least one pivotally attached jaw plate because Wang(130) suggests the use of such a construction in a pliers type of tool.

(11) Response to Argument

The primary reference to Small shows a VISEGRIP® pliers tool with a slide hammer attached for the purpose of applying a pulling force to a cylindrically shaped workpiece, i.e. a pin. As seen in figure 2, the shape of the jaws is similar to that of the workpiece in that it is a curve, thus it provides a more comprehensive gripping area around the workpiece. Claim 49 recites a jaw surface that is “substantially flat” as the intended workpiece is a shingle which is substantially flat. Verna also shows a VISEGRIP® pliers tool which grips a substantially flat piece of metal and uses a ring (14) that is secured to a winch to apply a pulling force to the VISEGRIP® pliers tool. As Verna engages a substantially flat piece of metal, the jaw gripping surfaces are designed to match the shape of the metal plate, i.e. substantially flat. The jaws have curved rows of teeth that when engaged with the metal plate provide for an evenly spaced gripping surface that matches the substantially flat surface of the metal plate. Thus when the workpiece shape is that of a substantially flat surface, one skilled in the art would be lead by Verna to construct the gripping surfaces of each jaw to match that of the workpiece.

Appellant states on page 12 of the brief that claims 56-59 should be grouped along with claim 49 and presents no separate argument as to the patentability of these claims. The final rejection, however grouped these claims with claim 60 for the reason that the method step of claim 56 referred to a “flat” surface of the jaw gripping the

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workpiece. As neither Small nor Verna show a completely flat surface, Want was cited to support the ground of rejection as it clearly shows a jaw gripping surface can be "flat" to engage a "flat" surface on a workpiece, e.g. a nut surface. However, as appellant has not presented any arguments with respect to the patentability of claims 56-59 separately from claims 49-55, no remarks can now be presented as to their unpatentability.

Appellant argues that there is no motivation in either Small or Verna to render claims 49-59 unpatentable as clearly Small does not contain "any disclosure or suggestion that its tool may be modified/used to grip flat objects". It appears that appellant is of the opinion that in order for a reference to render a claim obvious it must specifically state within the specification that it can be modified. This is clear error as if such a reference existed, it would clearly anticipate any such claim and there would never be a need for any obviousness rejection. What a proper section 103 rejection requires is that there be some motivation to make the proposed combination of references and clearly one skilled in the art having both Small and Verna would find such a motivation in that if the shape of the workpiece is substantially flat, then the shape of the jaw gripping surface should also be substantially flat in order to provide a even amount of pulling force across the entire jaw gripping surface. Both Small and Verna show that matching the shape of the gripping surface to that of the workpiece is desirable to accomplish this very fact.

Appellant also tries to refute the rejection by arguing that Small does not recognize the problem of the claimed invention, however the claimed invention as well

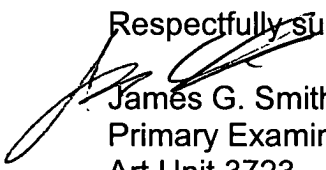
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as the tools in both Small and Verna are all VISEGRIP® pliers tool that have attachments for the purpose of applying a pulling force to the tool and thus to any workpiece engaged by the tool.

With respect to claim 60, this dependent claim adds only the feature of a pivotally attached jaw plate. Appellant argues this rejection by stating that all the cited art have different functions, however this is not true. All the cited patents are VISEGRIP® pliers tool that are used to lock onto a workpiece and both Small and Verna have the additional feature of a force applying mechanism. Wang merely suggests that in order to make a VISEGRIP® pliers tool more versatile, one of the jaw plates can be pivotally attached.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


James G. Smith
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jgs

June 1, 2004

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